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PATENT

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Betty L. Venuti

Applicant	: Calvin L. Loop, et al.
Application No.	: 10/016,653
Filed	: December 5, 2001
Title	: DESICCANT BAG WITH ENCLOSED EAS TAG AND SECURITY MARKINGS
Grp./Div.	: 2636
Examiner	: Daniel Previl
Docket No.	: 47493/RRP/D424

RESPONSE TO INITIAL REJECTION

Commissioner for Patents
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July 13, 2004

Commissioner:

Claims 1-6 of this application are under initial rejection as stated in an Office action of January 13, 2004. The rejection, under Section 103(a), is based on the following cited prior-art references:

a. U.S. Patent 5,790,029 - Curnutte, disclosing an EAS tag contained within a sealed plastic bag, and intended for theft-detection packaging with medicines or food stuffs.

b. U.S. Patent 5,743,942 - Shelley, disclosing a sealed bag containing desiccant material, and made of a vapor-permeable plastic such as marketed under the trademark TYVEK.

c. U.S. Patent 6,254,953 - Elston disclosing a product hang tag having an EAS tag, and having printed thereon "a logo, trademark, or other advertising."

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Granting that the invention defined by claims 1-4 of this application is largely a combination of the features disclosed in the Curnutte and Shelley references, the issue is whether it would have been obvious to one of ordinary skill in this technology to make such a combination as required under Section 103(a).

It must be conceded that almost every patentable and worthwhile invention is a combination of old and known components. The question is not as to the fact of a combination, but rather whether the making of the combination would have been "obvious" to a hypothetical ordinary-skill artisan.

Both the Examiner and undersigned counsel have doubtless seen many worthwhile inventions which seem, in hindsight, obvious ("of course, how simple, sure that's the way to do it," etc.), but hindsight is an improper test of obviousness, *Graham v. John Deere Co.*, 383 U.S. 1 (1965). Rather, to establish obviousness, there must be identified a prior-art teaching, suggestion, or incentive supporting the claimed combination, *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ 2d 1593 (Fed. Cir. 1987), and those factors are not found in the cited references.

The invention defined by claims 1-4 is a new and commercially successful product which provides the dual functions of desiccant adsorbance of water vapor, and antitheft protection for the product packaged with applicant's vapor-permeable bag which contains both a desiccant and an EAS tag. Such a combination is not shown or suggested in the prior art, and it is respectfully submitted that the rejection of claims 1-4 is improper, and should be withdrawn.

Claims 5-6 add to the invention defined by claim 1 the addition of a taggant printed on the outside of the bag. As described in the application (page 2, lines 17-25), a taggant is invisible in visible-light illumination, and can only be seen if activated by, for example, ultraviolet light. No such suggestion of a normally invisible taggant is found in the Elston reference, and the rejection is not properly based, and should be withdrawn.

Allowance of claims 1-6 is respectfully requested.

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Respectfully submitted,

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